

### **REMARKS**

No new matter is believed to be added to the application by this amendment.

#### **Status of the Claims**

Claims 1-20 are pending in the application. The amendments to claims 11, 14 and 15 correct minor errors.

#### **Objection to the Drawings**

The Examiner asserts that Figures 1A-1G should be designated by a legend such as "Prior Art". However, Figures 1A-1G are clearly labeled with the legend "Background Art". No admission as to prior art has been made in the specification or drawings of the application. As a result, there is no need or requirement to amend Figures 1A-1G with an additional legend to clarify them.

The failure of the specification and drawings to admit prior art is discussed in greater detail below.

#### **Rejection Under 35 USC §112, First Paragraph**

Claims 17-19 are rejected under 35 USC §112, first paragraph. Applicant traverses.

In paragraph 2 of the Office Action, the Examiner states "Claims 17 and 19 do not set forth process steps involved in the

method/process of forming non-sharp upper edges of the conductive layer." However, claim 17 clearly sets forth "performing CMP step forms non-sharp upper edges of the conductive layer." Similarly, claim 19 clearly sets forth "etching the conductive layer over the third insulating layer to expose the third insulating layer such that non-sharp upper edges of the conductive layer are formed." As a result, the non-sharp edges of the invention are clearly set forth in the claims.

Accordingly, this rejection is overcome and withdrawal thereof is respectfully requested.

**Rejection Under 35 USC §112, Second Paragraph**

Claims 11, 14, and 15 are rejected under 35 USC §112, second paragraph. Applicant traverses.

Claims 11, 14, and 15 as amended are clear, definite and have full antecedent basis. Accordingly, this rejection is overcome and withdrawal thereof is respectfully requested.

**Rejections Over Applicant's Disclosure**

Claims 1, 5, 11, and 12 are rejected over 35 USC §102(e) as being anticipated by the Applicant's disclosure. Claims 2-4, 17, and 19 are rejected under 35 USC §102(e) as being anticipated by or in the alternative under 35 USC §103(a) as being obvious over the

Applicant's disclosure. Claims 13-15 are rejected under 35 USC §103(a) as being unpatentable over the Applicant's disclosure in view of Matsuoka et al. (USP 5,130,449). Applicant traverses.

The Examiner uses the Applicant's disclosure to allege an admission as to prior art. However, there has been no admission as to prior art in the Applicant's disclosure.

The inability to utilize the disclosure without an admission as to prior art is well known. Most recently, the necessity for an applicant to admit prior art for an Examiner to utilize the disclosure as prior art has been set forth in Riverwood International Corporation v. R.A. Jones & Co., Inc., Slip OP. 02-1030, -1154 (CAFC March 31, 2003). For the Examiner's convenience, the relevant portion of Judge Linn's decision is set forth below:

This court and its predecessor have held that a statement by an applicant during prosecution identifying certain matter not the work of the inventor as "prior art" is an admission that the matter is prior art. In re Nomiya, 509 F.2d 566, 571 n.5, 184 USPQ 607, 611 n.5 (CCPA 1975). In Nomiya, the applicants filed a patent application containing two figures labeled as "prior art" and described as such in the specification. Id. at 570-71, 184 USPQ at 611. The examiner rejected the pending claims as obvious over a U.S. patent in light of the two figures. Id. The applicants argued that the figures could not constitute prior art absent a statutory basis in section 102. This court's predecessor disagreed: "By

filing an application containing Figs. 1 and 2, labeled prior art, ipsissimis verbis, and statements explanatory thereof appellants have conceded what is to be considered as prior art in determining obviousness of their improvement." Id. at 571, 184 USPQ at 611-12 (footnote omitted). Similarly, in Fout [675 F.2d 297, 300, 213 USPQ 532, 535 (CCPA 1982)], an applicant's admission of actual knowledge of the prior invention of another, which was described in the preamble of a Jepson claim, was held to constitute an admission that the described invention was prior art to the applicant. 675 F.2d at 301, 213 USPQ at 534.

While Nomiya and Fout stand for the proposition that a reference can become prior art by admission, that doctrine is inapplicable when the subject matter at issue is the inventor's own work. In In re Ehrreich, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), the examiner considered material from the preamble of a Jepson claim as prior art when making an obviousness rejection. Id. at 909-10, 200 USPQ at 510. The Ehrreich court found that rather than making an admission about the scope and content of the prior art, the applicant used Jepson language to avoid a double patenting rejection in the applicant's co-pending application. Id., 200 USPQ at 510. That co-pending application was not available to the public, was not the work of another, and was therefore not prior art under any statutory provision. The court concluded: "We think that a finding of obviousness should not be based on an implied admission erroneously creating imaginary prior art. That is not the intent of § 103." Id., 200 USPQ at 510.

In Reading & Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984), this court again considered an obviousness challenge to a patent in which certain claims referred to the patentee's own patent in both the specification section entitled "Summary of the Prior Art" and in the preamble to a Jepson claim. The Reading & Bates court held that the reference in the Jepson claim preamble to the applicant's own prior work was not prior art, citing the reasoning and policy of Ehrreich that "the preamble, standing alone, was not an admission that one's own prior work is prior art." Id. at 649, 223 USPQ at 1171. It also held that the patentee's discussion of his own patent in the specification section entitled "Summary of the Prior Art" did not constitute an admission that the patent was prior art. In reaching its conclusion, the court reviewed our precedent and recognized the "policy behind requiring a statutory basis before one's own work may be considered as prior art." Id. at 650, 223 USPQ at 1171 (citing In re Fout, 675 F.2d 297, 213 USPQ 532).

[T]here is an important distinction between the situation where the inventor improves upon his own invention and the situation where he improves upon the invention of another. In the former situation, where the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work.

Id., 223 USPQ at 1172. Riverwood at 11-13.

The Court then concludes that "the present case does not involve a Jepson preamble of an explicit reference in the specification to the prior art...one's own work may not be considered prior art in the absence of a statutory basis and a patentee should not be punished for being as inclusive as possible..." Riverwood at 14.

As a result, although a reference can become prior art by admission, prior art cannot be alleged when the subject matter at issue is the inventor's own work, as the Court in Riverwood interprets Nomiya, Fout, Ehrreich and Reading & Bates. Indeed, in the instant invention there is no clear delineation between the old and new of the inventor's work, such as in a Jepson claim. Here, the inventor merely is describing the problem to be solved.

Further, the teachings of Masuoka '449 fail to address the inability of the Applicant's disclosure to be utilized as prior art.

Accordingly, these rejections are overcome and withdrawal thereof is respectfully requested.

#### **Allowable Subject Matter**

The Examiner has allowed claim 20. The Examiner notes that claims 6-10 and 16 contain allowable subject matter.

**Prior Art Cited But Not Utilized by the Examiner**

The prior art cited but not utilized by the Examiner shows the status of the conventional art that the invention supercedes. Accordingly, no further remarks are necessary.

**Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

**Attached hereto is a marked-up version of the changes made to the application by this Amendment.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

IN THE CLAIMS:

The claims have been amended as follows:

11. (Amended) The method according to claim 1, wherein the [selective] sequentially etching step further forms a line along a boundary between the first region and a second region of the semiconductor substrate by removing the third insulation layer and of the second insulation layer.

14. (Amended) The method according to claim [16] 13 wherein the wet station is a bath type.

15. (Amended) The method according to claim [16] 13 wherein the wet station employs an IPA vapor drier.